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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,187

06/25/2004

Pierre Wuersch

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07/07/2006

EXAMINER

PRATT, HELEN F

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Bell Boyd & Lloyd  
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ART UNIT

PAPER NUMBER

1761

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/500,187

Applicant(s)

WUERSCH ET AL.

Examiner

Helen F. Pratt

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 3, 4-7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another MDC. In addition, the claims should say "to any one of claims...". See MPEP § 608.01(n). Applicants preliminary amendment is noted, however, no page 31 is found.

Claims 2-3, 4 are objected to because of the following informalities: proper Markush language is "from the group consisting of" instead of "from the group comprising". Appropriate correction is required.

Claims 8-10 provide for the use of viscous soluble fibers but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 8-10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ringe (5,024,996).

Ringe discloses a food product which contains soluble fiber, oat bran concentrate and cereal oat bran (claim 3) (abstract and col. 3, lines 55-56, 65-70, col. 9, lines 30-60, col. 4, lines 10-15, col. 5, lines 11-19, col. 6, lines 5-10). Soluble fiber as in claim 2 is disclosed in col. 5, lines 50-55. Claims 1 –3 differ from the reference in the particular amounts of oat bran concentrate. The reference does not disclose individual amounts of oat bran concentrate (obc) or oat bran. However, it is seen that it would have been within the skill of the ordinary worker to use particular amounts of OBC for its known function of adding a concentrated source of bran to the product. Therefore, it would have been obvious to use known ingredients in known amounts to make the claimed product.

Claim 4 further requires other ingredients such as sweeteners, and fat, which are disclosed in col. 6, lines 40-70. Other cereals, fruits and nuts are seen to have been common ingredients in cereals.

Claim 5 further requires that the composition be made into various forms. The reference discloses cereal, and cereal flakes. Nothing new is seen in making the composition into other forms such as a bar or a biscuit, which only further require a

Art Unit: 1761

binder. Certainly, cereal can be eaten as a snack. Since the composition is known as in claim 6, it would have been suitable for sports or food intake control because soluble fiber is known to enhance food intake by acting as a bulking agent. Therefore, it would have been obvious to make the composition into various forms, which are suitable as in claims 6-7 since the composition has been shown.

Claims 8-10 further require that the soluble fiber acts synergistically to increase the viscosity of a food product, which contains oat bran in particular amounts as in claim 10. However, soluble fiber is a hydrocolloid whose function is to act as a thickener. Therefore, it would have increased the viscosity of any product it is used with as in claims 8 and 9. Certainly, it would have been within the skill of the ordinary worker to use particular amounts as in claim 10 for their known functions which would have fulfilled the intended uses of the product since the composition is known. Therefore, it would have been obvious to make a product as shown by the reference, which has the composition and characteristics as in claims 8-10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 1761

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Hp 6-29-06

  
**HELEN PRATT**  
**PRIMARY EXAMINER**